

REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims are not anticipated under 35 U.S.C. § 102 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. **If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.**

The applicants will now address each of the issues raised in the outstanding Office Action. Before doing so, however, the Applicants would like to thank the Examiner for conducting a telephone interview on February 13, 2004.

Specification

The abstract had been amended to shorten it.

Objections

Claim 29 stands objected to because two different steps were both labeled "d)". Claim 29 has been amended to correct this error. Claims 33 and 34 have been similarly amended. Accordingly, this objection should be withdrawn.

Rejections under 35 U.S.C. § 112

Claims 1-9 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The Examiner contends that (1) claim 1 omits an essential step of providing a file which is to be added to the storage medium, and (2) it is unclear what has happened to the storage medium before the start of the method and it is difficult to determine whether the medium has been considered before. (See Paper No. 3, pages 2 and 3.) Each of these points is addressed below.

First, the applicants disagree what providing a file which is to be added to the storage medium is an essential step of the invention. For example, the present invention may be used with a storage medium that already contains one or more files, but that doesn't have a unique label identifier or a label based on a unique label identifier. As can be appreciated from this simple example, adding a file to the storage medium is not an essential step of the claimed method.

Second, claim 1 has been amended to clarify that act "a)" determines whether or not the storage medium has already been assigned a unique volume label and unique label identifier. Claim 20 has been similarly amended.

In view of foregoing, the applicants respectfully submit that this ground of rejection should be withdrawn.

Rejections under 35 U.S.C. § 102

Claims 1, 2, 5, 7-10, 12-16, 19-24, 26-29, 31-33, 35, 36 and 39 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,408,301 ("the Patton patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Before addressing at least some of the patentable features of the present invention, the Patton patent is introduced. The Patton patent concerns storing, indexing and retrieving images. More specifically, the Patton patent concerns "albuming" images and/or audio. Each of the images may be associated with Metadata, which is information associated with the image. (See, e.g., the Abstract and column 4, lines 20-39.) Thumbnail images, referred to as "Picons" in the Patton patent, may be used to represent a group of images, video, etc. (See, e.g., column 8, lines 51-67.) The images may have been recorded on a DVD provided in a camera. (See, e.g., Figs. 1-3.) A master index directory may use Picons and/or other Metadata to organize the images. This master index directory may be provided independent of the storage media and may have a disk ID and address pointers for indexed sequences of images. (See, e.g., Column 5, lines 3-5.) As can be appreciated from the foregoing, the Patton patent concerns using Metadata, such as Picons for example, to organize (e.g. index) images.

In contrast, various embodiments of the present invention may be used to (i) associate a label, such as a bar code label, with a storage medium and (ii) associate

the label with the contents of the storage medium. In this way, given a storage medium, a user can determine its contents, without needing to read the storage medium, by reading the label. Similarly, given a file, a user can determine the label of the storage medium on which the file is stored. The labels of various storage media can be quickly read, and an indication of whether or not the storage medium includes the file can be provided to a user.

Claims 1, 2, 5-9, 20-24, and 26-28

Independent claims 1 and 20 are not anticipated by the Patton patent because the Patton patent does not describe (means for) determining whether or not a storage medium has been assigned a unique label identifier, and if not, determining a unique label identifier for the storage medium and providing a command to generate a label, based on the unique label identifier, to be associated with the storage medium. The Examiner contends that (i) storage media that may be used by a camera discussed on column 3, lines 53-61 determine whether or not the storage medium has been considered before, (ii) a picture index memory discussed on column 3, line 61 determines a unique label identifier, (iii) a disk ID teaches a unique volume label, (iv) writing Picons teaches writing a unique volume label onto the storage medium, and (v) touch screen operation controls teaching providing a command to generate a label based on a unique label identifier. (See Paper no. 3, pages 3 and 4.)

The applicants respectfully disagree with a number of the Examiner's contentions. First, it is unclear how

a listing of storage media that may be used with a camera teaches determining whether or not a storage medium has been considered before, and relevant to the claims as amended, determining whether or not the storage medium has already been assigned a unique volume ID and a unique label ID. Accordingly, claims 1 and 20 are not anticipated by the Patton patent for at least this reason. Since claims 2, 5-9, 21-24, and 26-28 also include this feature by virtue of their dependency from claims 1 and 20, they are similarly not anticipated by the Patton patent.

Second, during the telephone interview, the Examiner confirmed that his position is that Picons of the Patton patent teach the claimed unique label identifier of the claimed invention. Although Picons are stored on the storage medium of the Patton patent, they are not generated "if the storage medium has not been assigned a unique volume label and a unique label identifier." Further, Picons are not determined for a storage medium. Rather, they are determined for images or sets of images. Accordingly, claims 1 and 20 are not anticipated by the Patton patent for at least this additional reason. Since claims 2, 5-9, 21-24, and 26-28 also include this feature by virtue of their dependency from claims 1 and 20, they are similarly not anticipated by the Patton patent.

Further regarding dependent claims 2 and 21, the Examiner contends that obtaining location information (from GPS) teaches synchronizing a database with a database on a device apart from the read/write machine. (Paper No. 3, pages 4 and 7.) Database synchronization is understood by those skilled in the art as making one

instance of a database conform to another instance of the database. The applicants fail to appreciate how determining a position teaches synchronizing a database. Accordingly, dependent claims 2 and 21 are not anticipated by the Patton patent for at least this additional reason.

Further regarding dependent claims 7 and 26, the Examiner contends that using a touch screen display to view Picons or icons, view video sequences, view still images or groups of still images, etc. teaches determining a volume label based, at least in part, on state information accessible to the read/write machine. (See Paper No. 3, pages 4 and 8.) Earlier, the Examiner contended that the disk ID of the Patton patent teaches a volume label. (See Paper No. 3, page 4.) The applicants respectfully submit that viewing various items using a touch screen does not teach determining a disk ID. Accordingly, claims 7 and 26 are not anticipated by the Patton patent for at least this additional reason.

Claims 10, 12-14, 29 and 31-33

— Formerly independent claims 10 and 29 have been rewritten to depend from claims 1 and 20, respectively. These claims are not anticipated by the Patton patent because the Patton patent does not describe (means for) accepting information read from the unique label identifier associated with a storage medium without reading the storage medium and converting such information into a database key. The Examiner cites the use of a master picture directory having address pointers for indexed sequences as teaching this feature. (See Paper No. 4, page 5.) Although the Patton patent

describes that the master picture directory can be independent from the master picture directory, it apparently uses a disk ID (which the Examiner earlier contended is a unique volume label), not a unique label identifier associated with the storage medium (which the Examiner earlier contended was taught by a Picon). Accordingly, claims 10 and 29 are not anticipate by the Patton patent for at least this reason. Moreover, since these claims have been amended to depend from claims 1 and 20, respectively, they are not anticipated by the Patton patent for the reasons discussed above with reference to claims 1 and 20. Since claims 12-14 and 31-33 include the features of claims 10 and 29, respectively, by virtue of their dependency, these claims are similarly not anticipated by the Patton patent.

Claims 15, 16, 19, 35, 36 and 39

Independent claims 15 and 39 are not anticipated by the Patton patent because the Patton patent does not describe (means for) rendering information associated with each of one or more records accepted, the information rendered being related to a label provided on a storage medium without storing it on the storage medium, wherein the storage medium stores one or more files identified with the one or more records accepted.

The Examiner contends that the voice actuated image and audio albuming feature of the Patton patent, in which a voice input can be used to access stored images, teaches rendering information associated with each of one or more records accepted, the information rendered being related to a label associated with the storage medium

which stores one or more files identified with the one or more records accepted. (See Paper No. 3, page 6.)

Independent claims 15 and 39 have been amended to recite that the label is provided on the storage medium without storing it on the storage medium to further distinguish these claims over the Patton patent. Accordingly, these claims are not anticipated by the Patton patent. Since claims 16 and 19 depend from claim 15 and since claims 36 and 39 depend from claim 29, these claims are similarly not anticipated by the Patton patent.

Rejections under 35 U.S.C. § 103

Claims 6, 11, 25 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Patton patent. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The Examiner concedes that the Patton patent fails to teach a bar code label. To compensate for this admitted deficiency of the Patton patent, the Examiner contends that (i) the bar code labels are well known in the art, and (ii) that one of ordinary skill in the art would have been motivated to modify the Patton patent to include a bar code label for the purpose of making an automatic entry of information via a handheld scanner. (See Paper No. 3, page 11.)

The applicants respectfully disagree with the Examiner's conclusion as to motivation to modify. More specifically, the Examiner earlier contends that the Picons in the Patton patent teach the claimed label.

(See Paper No. 3, page 4.) Picons are a thumbnail image and are used to represent a plurality of images grouped together under a common theme. Thus, Picons are used as a visual cue to help users organize and retrieve images. Replacing Picons with bar code labels would destroy the utility of helping users to organize and retrieve images using visual cues. Clearly, one skilled in the art would not have been motivated to modify the Patton patent as proposed by the Examiner. Accordingly, claims 6, 11, 25 and 30 are not rendered obvious by the Patton patent for at least this reason.

Further, even assuming, arguendo, that one skilled in the art would have been motivated to replace Picons with bar code labels, this does not compensate for the deficiencies of the Patton patent with respect to claims 1, 10, 20 and 29 discussed above. Since claims 6, 11, 25 and 30 depend from claims 1, 10, 20 and 29, respectively, these claims are not rendered obvious by the Patton patent for at least this additional reason.

Claims 3, 4 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Patton patent in view of U.S. Publication No. 2003/0161614 ("the Yanagihara publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The Examiner concedes that the Patton patent fails to disclose that the read/write machine is a personal computer. To compensate for this admitted deficiency, the Examiner (i) relies on the Yanagihara publication as teaching a read/write machine being a personal computer, and (ii) contends that it would have been obvious to

modify the Patton patent to include a personal computer to provide a convenient means for editing, displaying and transporting images over the Internet. (Paper No. 3, pages 12 and 13.) The applicants respectfully disagree.

As shown in Figures 1-3, the Patton patent describes a camera as the means for writing image data onto a disk. Although the image data on the disk can be later manipulated by other devices, the image data is written by the camera. Clearly, one skilled in the art would not have been motivated to include a personal computer in a camera. Doing so might destroy portability features desirable in a camera such as light weight, low battery consumption, not to mention low cost. Accordingly, claims 3, 4 and 34 are not rendered obvious by the Patton patent and Yanagihara publication for at least this reason.

Moreover, with respect to claim 34, the Examiner contends that element 16 of Figure 1 of the Yanagihara publication discloses means for synchronizing a database with a database maintained on a separate machine. (See Paper No. 3, page 13.) The cited reference is a DVD drive. It is unclear how the mere provision of a DVD drive teaches or suggests means for synchronizing a database with a database maintained on a separate machine. Accordingly, claim 34 is not rendered obvious by the Patton patent and Yanagihara publication for at least this additional reason.

Further, even assuming, arguendo, that one skilled in the art would have been motivated to include a personal computer in the camera of the Patton patent, this does not compensate for the deficiencies of the Patton patent with respect to claims 1 and 29 discussed

above. Since claims 3 and 4 include the features of claim 1 by virtue of their dependency, and since claim 34 includes the features of claim 29 by virtue of its dependency, these claims are not rendered obvious by the Patton and Yanagihara patents for at least this additional reason.

Claims 17, 18, 37 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Patton patent in view of U.S. Publication No. 2001/0018356 ("the Cathey publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The Examiner concedes that the Patton patent does not teach that if accepted information read from a machine readable label does not match information associated with any one of one or more records accepted, then generating a second indicator which is able to be perceived by humans. The Examiner relies on the Cathey publication to compensate for this admitted deficiency. More specifically, the Examiner contends that paragraph 10 of the Cathey publication teaches this. (See Paper No. 3, page 14.) This paragraph concerns providing a visible or audible warning that notifies a user of a low battery condition in a pager/cellphone device. This clearly does not compensate for the admitted deficiency of the Patton patent with respect to claims 17, 18, 37 and 38. Accordingly, these claims are not rendered obvious by the Patton patent and the Cathey publication for at least this reason.

Further, this purported teaching of the Cathey publication does not compensate for the deficiencies of

the Patton patent with respect to claims 16 and 36 discussed above. Since claims 17 and 18 include the features of claim 16 by virtue of their dependency, and since claims 37 and 38 include the features of claim 36 by virtue of their dependency, these claims are not rendered obvious by the Patton patent and the Cathey publication for at least this additional reason.

New claims

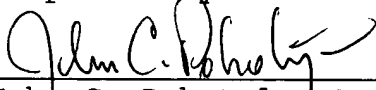
New method claim 40 and new apparatus claim 41 depend from claims 1 and 20, respectively, and further recite (means for), if the storage medium has not been assigned a unique volume label and a unique label identifier then further, (i) generating a label based on the unique label identifier, and (ii) fixing the generated label to the storage medium without storing it on the storage medium. These claims further distinguish the invention over the cited art.

Conclusion

In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

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Respectfully submitted,


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